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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/876,813

06/06/2001

Teresa Gilbert

99-19D1

9714

7590

04/14/2004

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/876,813

Applicant(s)

GILBERT ET AL.

Examiner

Olga N. Chernyshev

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21, 32-38, 42-47 and 49-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-21, 43-47 and 49-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-35 and 56 is/are allowed.
- 6) ☒ Claim(s) 36-38, 42 and 57-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/15/1.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II and election of polypeptide of SEQ ID NO: 2, fragment 250-370, in Paper filed December 15, 2003 is acknowledged.

Claims that encompass the elected invention are as follows: claims 32-38, 42 and 56-59.

Claims 1-21, 43-47 and 49-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed on December 15, 2003.

Claims 32-38, 42 and 56-59 are under examination in the instant office action.

### *Sequence compliance*

2. It is noted that Sequence listing submitted on June 06, 2001 identifies 53 sequences in the instant application, while the printout of the CRF entered on August 06, 2003 lists 57 sequences. Therefore, it appears that the content of the sequence listing paper copy is not identical to the content of the computer readable form. Clarification is required.

### *Drawings*

3. Figure 1 of the instant application is presented on separate pages or in separate panels. 37 C.F.R. § 1.84(u) (1) states that when partial views of a drawing which are intended to form one complete view, whether contained on one or several sheets, must be identified by the same number followed by a capital letter. For example, the seven pages of Figure 1 in the instant specification should be renumbered "Figure 1A" – "Figure 1G" rather than "Figure 1". Applicant

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is reminded that once the drawings are changed to meet the separate numbering requirement of 37 C.F.R. § 1.84(u) (1), the specification should be amended to change the Brief Description of the Drawings and the rest of the specification to refer to each Figure accordingly. If, for example, Figure 1 is divided into Figures 1A-1G, then the Brief Description and all the references to this figure in the specification must refer to this Figure in the same manner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 36-38, 42 and 57-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 36 recites the limitation "DNA polynucleotide" in claim 32. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 42 recites the limitation "DNA segment" in claim 36. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 42 is further vague and indefinite for recitation "a polypeptide". Claim 42 is directed to a method of producing a polypeptide. It is obvious that "a cell into which has been introduced an expression vector according to claim 36" expresses and produces a plurality of polypeptides, not necessarily related to the polypeptide encoded by the DNA of claim 32. Therefore, the metes and bounds of "a polypeptide" cannot be determined from the claim.
8. Claims 37-38 and 57-59 are indefinite for being dependent from indefinite claims.

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***Conclusion***

9. Claims 32-35 and 56 are allowed. Claims 36-38, 42 and 57-59 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 872-9306. If this number is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (571) 273-0870. Official papers should NOT be faxed to (571) 273-0870.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Olga N. Chernyshev, Ph.D.

  
**OLGA N. CHERNYSHEV, PH.D.**  
**PATENT EXAMINER**